



09/577,909

#11
PATENT 7-12.

04/12/04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Gabriel J. Hall et al. Examiner: England, David E.
Serial No.: 09/577,909 Group Art Unit: 2143
Filed: May 24, 2000 Docket No.: MS149405.1/40062.173US01
Title: SYSTEM AND METHOD FOR SENDING A WEB PAGE VIA
ELECTRONIC MAIL

CERTIFICATE UNDER 37 CFR 1.10:

"Express Mail" mailing label number: EV 299846046 US
Date of Deposit: April 2, 2004

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APPEAL BRIEF TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Mail Stop Appeal Brief-Patents
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This brief is presented in support of the Notice of Appeal filed on February 3, 2004, from the Final Rejection of claims 1-35 of the above identified reissue application, as set forth in the Final Office Action mailed October 3, 2003, and subsequent Advisory Action mailed December 23, 2003.

The Appeal Brief is filed in triplicate. A check in the amount of \$330.00 is enclosed for the requisite fee set forth in 37 C.F.R. § 1.17(c). Please charge any additional fees or credit any overpayment to Merchant & Gould P.C., Deposit Account No. 13-2725. Appellant respectfully requests reversal of the Examiner's rejection of pending claims 1-35.

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Real Party in Interest

The present application has been assigned to Microsoft Corporation, a corporation organized and existing under and by virtue of the laws of the State of Washington, and having an office and place of business at One Microsoft Way, Redmond, Washington 98052.

Related Appeals and Interferences

There are no other appeals or interferences known to appellant that would have a bearing on the Board's decision in the present appeal.

Status of the Claims

The present application includes pending claims 1-35 and all pending claims stand rejected by the Examiner.

Status of the Amendments

In response to the Final Office Action, appellant filed an after-final response presenting many of the same arguments found below. There were **no proposed amendments** to the claims presented in the after-final response. In an Advisory Action mailed December 23, 2003, the Examiner indicated these arguments did not place the application in condition for allowance.

Summary of the Invention

The presently claimed invention relates to the automatic packing of web pages (i.e., a main HTML page and any supporting resource files) into a single file and, in particular, to the automatic attachment of such a single file to an email note so that a recipient of the email can extract and display the web page in its original form. The entire process is automatic so that a user can simply drag a main web page (i.e., the main HTML document) into an email note without being required to further attach any of the supporting resource files. In one embodiment, the main web page and all supporting resource files are packaged into a single file utilizing the Multipurpose Internet Mail Extensions encapsulated HTML ("MHTML") format.

The independent claims specifically recite a method (or system in claim 22) of automatically attaching a web page to an email note as a single file, where the method includes

the preliminary steps of detecting when a user is attaching a web page to an email note and determining whether the web page includes any links to “resource files” (i.e., files that are separate from the main HTML document). These preliminary steps are illustrated in the flow chart of FIG. 4 and described in detail at pages 13-16 of the present application. A preferred method of packing the web page and the supporting resource files into an MHTML format is described at pages 10-12 of the present application, although the application specifically notes that the invention may be used with “any format that [permits] the packing of a web page and all accompanying resource files into a single file for email transmission.” (Application at p. 12.)

Thus, the present invention, as typified by claim 1, recites a method of automatically attaching a web page to an email note as a **single file**. The recitation of a single file is key to the patentability of the claim since, as noted in the Background portion of the present application, “no currently available email client supports attaching a folder to an email note.” (Application at page 2, lines 11-12.) Thus, as described in greater detail below, it is not currently possible to attach an entire directory or “folder” to an email note where the folder may contain all the resource files necessary to view the web page. Additionally, while it is presently possible to attach a web page to an email note by attaching a **plurality** of files to the email note (i.e., attaching both the main HTML document and all the supporting resource files), such a method is cumbersome for both the sender and the recipient of the email note.

Additionally, the present invention simplifies the process of sending a web page to an email recipient by automatically performing all of the packing steps in the background so that a user need only attach (i.e., copy or “drag”) a main web page to an email note without being required to first save and then attach all of the required files. Indeed, these preliminary steps are recited as the first two steps of independent claim 1 of the present application.

Issue

The issue on appeal is whether the pending claims 1-35 are patentable over the combination of references cited by the Examiner, and in particular whether the independent claims 1, 10, 22 and 29 are patentable over the single § 102(e) reference cited in both the first and final Office actions. Specifically, the Examiner rejected independent claims 1, 10, 22 and 29 as being anticipated by Mantha et al. (US 6,163,779). As detailed below, Applicant asserts that the Mantha et al. patent does not disclose each of the limitations of the independent claims, nor does Mantha et al. teach or suggest the invention of automatically attaching a web page to an email note as a single file so as to render the pending claims obvious.

Grouping of the Claims

For the purposes of the present appeal, the claims stand or fall together and the Board may select any of the independent claims to decide the appeal. For the purposes of the following argument, reference is specifically made to method claim 1, although the same arguments relating to the grounds of rejection apply to the remaining independent claims.

Argument

The § 102(e) rejections of the independent claims based on Mantha et al. (U.S. 6,163,779) are inappropriate and should be reversed on appeal for the simple fact that the method steps of claim 1 are not found in the Mantha et al. patent.

Mantha et al. relates to saving a web page on a local hard drive (e.g., the hard drive of an Internet appliance that is used primarily as a web client) so that a user may “take a ‘snap shot’ of a particular Web page” and then retrieve the saved page for subsequent viewing. (Mantha et al. at col. 1, lines 55-58). Specifically, as shown by the user interface screenshots in FIGS. 5 and 7 of the Mantha patent, a user may elect to save a currently-displayed web page by selecting on-screen icons to determine the location (e.g., the “Favorites” category) in which to store the web page.

With respect to the particular process used to store the web pages, Mantha et al. describes a process which is similar to other prior art processes used to store a web page. Specifically, Mantha et al. describes copying the base HTML document and each of its embedded objects

(e.g., images) onto a local hard drive. (See col. 2, lines 11-13.) Mantha et al. then describes changing any links in the base HTML document to point to the files on the hard drive, while other hypertext references in the base document are stored as fully-qualified network URLs. (See col. 2, lines 14-18.) However, while Mantha et al. describes storing a copy of a web page (along with the supporting resource files), Mantha does not describe packing these separate and distinct files into a **single file** as recited in the pending claims. Furthermore, Mantha et al. does not disclose or suggest automatically packing or attaching such files to an email note in response to a user's request to attach the main web page (i.e., the base HTML document) to the email note. Both of these deficiencies of the Mantha patent are described in greater detail below.

Mantha et al. Does Not Disclose or Suggest Packing a Web Page Into a Single File

In both the initial and final Office action (as well as in the Advisory Action), the Examiner has alleged that Mantha et al. teaches packing a web page along with its resource files into a single attachment file. See Office Action of October 3, 2003, at page 8 (para. 39). The Examiner quoted a specific passage from Mantha et al. in arguing that Mantha anticipates the independent claims as excerpted below:

“The file directory for the copied pages (e.g., c:\user\copies\c1\c1.htm, i1.jpg, etc.)) is self-contained and needs no other files or system dependent information to view the copied page. As a result, the invention may be used with an e-mail application to simplify the transfer of the saved Web page. In particular, the user simply attaches a copy of the directory contents to the email and all embedded files get transferred.” This is found in column 13, lines 40-47 in Mantha. If the Applicant would look at the example they would notice that it is one directory with multiple resource files in the directory.” (Id. at pp. 8-9, emphasis in original.)

The crux of the present appeal is immediately apparent from the Examiner's arguments and the underlined portions in the above quote. Specifically, the Examiner is citing a portion of the Mantha et al. patent that describes the ability of a user to “attach a copy of the directory contents to an email” in order to transfer the saved web page. In other words, Mantha et al. describes the prior art process of attaching a plurality of separate files to an email note in order to transfer the complete web page. The Examiner has focused on a statement in the Mantha patent that this process is facilitated in the case of the Mantha invention because all of the necessary documents have been stored in one directory (i.e., the “c1” directory in the above-quoted

example), and the base HTML document has already been modified with updated links to the embedded files. However, the Examiner is plainly incorrect in his assertion that Mantha et al. discloses or suggests attaching a **single file** to an email note as recited in the pending claims. Indeed, in the very quote relied on by the Examiner, Mantha et al. describes attaching the “directory contents” (i.e., the copied pages “c1.htm, i1.jpg, etc.”) to the email note to ensure that all the embedded files are transferred. That is, Mantha describes attaching all of the contents of the “c1” directory to the email note.

Thus, contrary to the position taken by the Examiner, Mantha et al. does not disclose or suggest packing all the required documents into a **single file** for attachment to an email note. Rather, Mantha simply describes the prior art technique of attaching all the files separately, although Mantha first stores all the files in one central location to “simplify the transfer” as described at col. 13, lines 42-47. Furthermore, while the Examiner is apparently relying on the fact that Mantha et al. stores all the files for the web page in one directory (e.g., the “c1” directory in the above example), it is apparent that Mantha does not describe or suggest attaching the entire directory to an email note. Indeed, as noted above and as described in the Background section of the present application, it is not currently possible to attach an entire directory or “folder” to an email note where the folder may contain all the resource files necessary to view the web page. See the Application at page 2, lines 11-15.

Therefore, to the extent that the Examiner is alleging that Mantha et al. describes attaching a single file to an email note, the Examiner is mistaken as explained above. On the other hand, to the extent that the Examiner is alleging that Mantha et al. teaches the attachment of an entire directory (containing the base HTML document and all the necessary resource files) to an email note, Applicant responds that there is no such teaching in Mantha and that such a suggestion (even if it were present, which it is not) is simply not possible as described in the Background section of the present application.

In sum, Mantha et al. describes the basic invention of saving a web page to a local drive for later viewing. Mantha further recognizes that once the web page has been saved in a single directory it is possible to attach all of the files within the directory to an email for transfer to another user. However, Mantha does not describe or suggest packing all of the files necessary for viewing a web page into a single file and then attaching that single file to an email note. Therefore, the § 102(e) rejections of all the pending claims must be reversed. Additionally,

while the Examiner has cited several additional references in combination with Mantha et al. in order to reject a number of the pending dependent claims, none of these secondary references provide any teaching that would cure the above-described deficiencies of the Mantha patent. Specifically, none of the secondary references teach or suggest automatically packing a plurality of files into a single file in order to email an entire web page to a recipient.

Mantha et al. Does Not Disclose or Suggest Automatically
Packing the Files In Response to a Request to Attach a Web Site

Each of the independent method claims of the present application recite preliminary steps relating to detecting that a web page is to be attached to an email note, as well as determining that the web page includes one or more links to resource files. Only in response to these initial determinations do the independent method claims recite the step of packing the web page files into a single file and then attaching that single file to the email note. (Independent system claim 22 contains analogous limitations relating to a recited email client). The Examiner cites columns 8-12 of the Mantha et al. patent as allegedly disclosing these preliminary steps. See Office Action of October 3, 2003, at page 2 (paras. 4-6). However, the cited portions of Mantha et al. simply relate to the use of a client machine (such as an Internet appliance) to browse the web and ultimately save a copy of a desired web page to local storage. While Mantha later describes (col. 13, lines 42-47) that a user may elect to email the plurality of web page files after they have been stored to a common directory (see above discussion), Mantha does not provide any earlier discussion or suggestion of emailing a web page. Indeed, the undersigned conducted a search of the Mantha specification for any discussion of emailing web pages, and the above-quoted discussion (column 13, line 42) is the only portion of the Mantha patent that mentions emailing web pages.

Thus, Mantha et al. does not describe the presently claimed invention where a user who desires to send a web page to an email recipient simply elects to attach or “drag” the main web page to an email note while the steps of scanning the web page for resource files and packing all the associated files into a single file for attachment to the email note occur “in the background.” As described above with respect to the “single file” limitation, Mantha et al. simply describes a process of saving a web page (and its associated resource files) to a local drive. The purpose of saving the web page to local storage is to allow a user to “take a snap shot” in time of the web

page so that the exact same web page may be viewed later. Col. 1, lines 55-58. Only at the conclusion of the specification does Mantha recognize that a user may also attach the plurality of saved files (i.e., the main HTML document and the resource files) to an email note. Mantha thus does not teach or suggest automatically attaching all the necessary files to an email in response to a user's request to email only the main HTML page.


In sum, Mantha does not disclose or suggest packing all of the necessary files into a single file for attachment to an email note. Rather, Mantha simply recognizes that, once a plurality of web page files have been saved to a local drive, the files may be attached to an email. Mantha does not, however, disclose or suggest that the resource files should be automatically attached in response to a user request to email the main web page.

CONCLUSION

Mantha fails to anticipate or render obvious the inventions recited in the pending independent claims. Specifically, Mantha describes a process for storing web pages to a local drive and suggests that the saved files (i.e., the main HTML file and all the supporting reference files) may be attached to an email note to facilitate transferring the web site. Contrary to the Examiner's arguments, Mantha does not describe packing all of the supporting web page files into a single document as recited in the pending claims. Rather, Mantha simply describes saving the plurality of files within a single directory so that the files can be easily located and attached to an email if desired. However, Mantha fails to describe or suggest the steps of packing the web page files into a single file and attaching the single file in response to detecting that a user has requested that a main web page be attached to the email note.

For these reasons, it is apparent that the § 102 rejections of the pending independent claims is inappropriate. Reversal of the Examiner's rejections of claims 1-35 is therefore respectfully requested.

Date: April 2, 2004



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APPENDIX A

Listing of Pending Claims Involved in the Appeal

1. A method for automatically attaching a web page as a single file to an email note, the method comprising the steps of:
 - in response to an attachment event, determining whether a selected file is a web page;
 - in response to a determination that the selected file is a web page, determining whether the selected file includes at least one link to at least one resource file; and
 - in response to a determination that the selected file includes at least one link to at least one resource file, packing the selected file and the at least one resource file into a single attachment file and attaching the attachment file to the email note.
2. The method of claim 1, wherein the attachment event comprises a user dragging the selected file into the email note.
3. The method of claim 1, wherein the attachment event comprises a user dragging the selected file into the email note.
4. The method of claim 1, wherein the attachment event comprises a user copying the selected file into the email note.
5. The method of claim 1, wherein the step of determining that the selected file is a web page comprises determining whether the selected file has an “.htm” extension.
6. The method of claim 1, wherein the step of determining that the selected file is a web page comprises determining whether the selected file has an “.html” extension.
7. The method of claim 1, wherein the step of determining that the selected file includes at least one link to at least one resource file comprises determining whether the selected file includes a tag including the string: <ling rel=FileList href=>.

8. The method of claim 1, wherein the step of determining that the selected file includes at least one link to at least one resource file comprises determining whether the selected file includes a link tag selected from the group of:

;
;
;
<body background=>;
<script src=>;
<bgsound src=>;
<embed src=>; and
<link rel="stylesheet">.

9. The method of claim 1, wherein the step of packing the selected file and the at least one resource file into a single attachment file comprises converting the selected file and the at least one resource file into an MHTML file.

10. A method for automatically attaching a web page as a single file to an email note, the method comprising the steps of:

determining that a user desires to attach a selected file to the email note;
determining whether the selected file is a web page;
in response to a determination that the selected file is a web page, determining whether the selected file includes at least one link to at least one resource file; and
in response to a determination that the selected file includes at least one link to at least one resource file, determining whether automatic attachment of the at least one resource file has been authorized; and
in response to a determination that automatic attachment of the at least one resource file has been authorized, packaging the selected file and the at least one resource file into a single attachment file and attaching the attachment file to the email note.

11. The method of claim 10, wherein the step of determining that a user desires to attach a file to the email note comprises determining that a user has dragged the selected file into the email note.

12. The method of claim 10, wherein the step of determining that a user desires to attach a file to the email note comprises determining that a user has inserted the selected file into the email note.

13. The method of claim 10, wherein the step of determining that a user desires to attach a file to the email note comprises determining that a user has copied the selected file into the email note.

14. The method of claim 10, wherein the step of determining that the selected file is a web page comprises determining whether the selected file has an “.htm” extension.

15. The method of claim 10, wherein the step of determining that the selected file is a web page comprises determining whether the selected file has an “.html” extension.

16. The method of claim 10, wherein the step of determining that the selected file includes at least one link to at least one resource file comprises determining whether the selected file includes a tag including the string: <link rel=FileList href=>.

17. The method of claim 10, wherein the step of determining that the selected file includes at least one link to at least one resource file comprises determining whether the selected file includes a link tag selected from the group of:

;

;

;

<body background=>;

<script src=>;

<bgsound src=>;

<embed src=>; and
<link rel="stylesheet">.

18. The method of claim 10, wherein the step of determining whether automatic attachment of the at least one resource file has been authorized comprises determining the status of at least one registry key.

19. The method of claim 18, wherein the step of determining the status of at least one registry key comprises determining the status of a web page packing registry key.

20. The method of claim 19, wherein the step of determining the status of at least one registry key comprises determining the status of an automatic packing registry key.

21. The method of claim 10, wherein the step of packing the selected file and the at least one resource file into a single attachment file comprises converting the selected file and the at least one resource file into an MHTML file.

22. A system for automatically attaching a web page as a single file to an email note, the system comprising:

an email client for generating and transmitting an email note;

a web page with at least one link to at least one resource file;

a web page packing object operative to pack the web page and at least one resource file into a single web archive file;

wherein the email client is operative to detect the attachment of the web page to the email note and to automatically trigger the web page packing object to pack the web page and at least one resource file into the single web archive file.

23. The system of 22, wherein the at least one link comprises a tag including the string: <link rel=FileList href=>.

24. The system of 22, wherein the at least one link comprises a link tag selected from the group of:

;
;
;
<body background=>;
<script src=>;
<bgsound src=>;
<embed src=>; and
<link rel="stylesheet">.

25. The system of 22, wherein the single web archive file comprises an MHTML file.

26. The system of 22, wherein the attachment of the web page to the email note comprises a user dragging the web page into the email note.

27. The system of 22, wherein the attachment of the web page to the email note a user inserting the web page into the email note.

28. The system of 22, wherein the attachment of the web page to the email note comprises a user copying the web page into the email note.

29. A method for automatically attaching a web page as a single file to an email note, the method comprising the acts of:

detecting an attachment event indicating a selected file is to be attached to the email note;
determining whether the selected file is a web page;
determining whether the selected file includes one or more links to resource files; and
in response to a determination that the selected file includes one or more links to resource files, packing the selected file and the one or more resource files into a single attachment file and attaching the attachment file to the email note.

30. The method of claim 29 further comprising:
determining whether automatic attachment of resource files for the web page has been authorized.
31. The method of claim 30 wherein the acts of packing and attaching are in response to both a determination that attachment of resource files has been authorized and to the determination that the selected file includes one or more links to resource files.
32. The method of claim 31, wherein the act of determining that the selected file includes one or more links to resource files comprises determining whether the selected file includes one or more link tags.
33. The method of claim 31, wherein the act of determining whether automatic attachment of the at least one resource file has been authorized comprises determining the status of at least one registry key.
34. The method of claim 33, wherein the act of determining the status of at least one registry key comprises determining the status of a web page packing registry key.
35. The method of claim 33, wherein the act of determining the status of at least one registry key comprises determining the status of an automatic packing registry key.



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Gabriel J. Hall et al. Examiner: England, David E.
Serial No.: 09/577,909 Group Art Unit: 2143
Filed: May 24, 2000 Docket: MS149405.1/40062.173US01
Confirmation No. 4482

Title: SYSTEM AND METHOD FOR SENDING A WEB PAGE VIA ELECTRONIC MAIL

CERTIFICATE UNDER 37 CFR 1.10:

"Express Mail" mailing label number: EV 299846046 US
Date of Deposit: April 2, 2004

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By: Charlene Huffman
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